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Dkt. 71342-PCT-US/JPW/GJG/LCM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Zhongyi Li, et al.

Serial No. : 10/577,564

Filed : April 27, 2006

For : RICE AND PRODUCTS THEREOF HAVING STARCH WITH AN INCREASED PROPORTION OF AMYLOSE

30 Rockefeller Plaza
20th Floor
New York, NY 10112
December 12, 2008

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO SEPTEMBER 22, 2008 OFFICE ACTION AND PETITION FOR A TWO-MONTH EXTENSION OF TIME

This Communication is submitted in response to the September 22, 2008 Office Action issued in connection with the above-identified application. A response to the September 22, 2008 Office Action was due October 22, 2008. Applicants hereby petition for a two-month extension of time. The fee for a two-month extension of time is FOUR HUNDRED AND NINETY DOLLARS ($490.00), and a check for this amount is enclosed. With a two-month extension of time, a response to the September 22, 2008 Office Action is now due December 22, 2008. Accordingly, this response is being timely filed.

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Restriction Requirement Under 35 U.S.C. §121

In the September 22, 2008 Office Action, the Examiner required restriction to one of the following groups under 35 U.S.C. §121:

I. Claim(s) 1-4, 7-20, 24, 37, and 40 drawn to a grain obtained from a rice plant wherein a mutation of an SBEIIa gene and a mutation of an SBEIIb gene reduce the levels or activities of SBEIIa and SBEIIb.

II. Claim(s) 1-6, 8-14, 17-20, 40, 41, and 43 drawn to a grain obtained from a rice plant wherein an introduced nucleic acid inhibits both SBEIIa and SBEIIb.

The Examiner alleged that the inventions are distinct, each from the other, because each of the inventions requires consideration of separate issues relating to assessment of novelty, obviousness, utility, written description and enablement.

Applicants' Response

In response, applicants hereby elect, with traverse, to prosecute the invention of Examiner's Group II, drawn to a grain obtained from a rice plant wherein an introduced nucleic acid inhibits both SBEIIa and SBEIIb.

35 U.S.C. §121

Applicants traverse the restriction on the basis that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Director may require application to be restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the claims of Groups I-II are not independent.

Under M.P.E.P. §802.1, "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, and effect...". The claims of Group I and II are related in that they are drawn to similar compounds, compositions, and methods of use. All of the methods relate to inhibition of SBEIIa and SBEIIb.

Applicants therefore respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01. Therefore, restriction is improper under 35 U.S.C. §121.

Additionally, applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to any of Groups I or II would likely identify art for the other Group. Since there is no serious burden on the Examiner to examine Groups I and II in the subject application, the Examiner must examine the entire application on the merits.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine all pending claims on the merits.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed $490.00 fee for a two-month extension of time, is deemed necessary in connection with the filing of this Communication. If any such fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Gary J. Gershik

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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Gary J. Gershik 12/12/08
Gary J. Gershik Date
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